

REMARKS/ARGUMENTS

Claims 1-8 were presented for examination. Claims 3 and 4 were rejected under 35 USC 112 as having elements with insufficient antecedent basis. Claims 1-8 were rejected under 35 USC 102(e) as being anticipated by Ryan (US 6,173,274).

Claims 3 and 4 have been amended. No claims have been cancelled and no new claims have been added.

35 U.S.C. 112 Rejections

Claim 3 has been amended to replace “customer” with “user”. Claim 4 has been amended to clarify that the tools are provided “by a business”.

35 U.S.C. 102 Rejections

In the Office Action, claims 1-8 were rejected under 35 U.S.C. 102(e) as being anticipated by Ryan. As discussed below, Ryan fails to teach or suggest the claimed methods.

Looking first at the teaching of the Ryan reference, Ryan discloses a system wherein a user who is having mail pieces printed, inserted into an envelope, and prepared for mailing can earn credit value that will be applied to the user’s account if the user will authorize the printing of a third party message on the envelope in which the user’s materials are being mailed. (see Ryan col. 10, lines 6-9) The manner in which the Ryan system works is depicted in Fig. 6 and discussed at col. 11, line 27 to col. 13, line 10. In particular, referring to steps 610 and 612 (col. 12, lines 23-29),

the Ryan user reviews the available advertisements and selects the advertisement to be printed on the user's envelope.

Ryan fails to teach or suggests Applicants' claimed methods. First, pending independent claim 1 recites providing "product design tools" that "allow a user to create an electronic product design". Ryan does not disclose such tools and the Ryan user is not allowed to perform any actions that reasonably would be considered to constitute the creation of an electronic product design. As indicated at col. 12, lines 23-29, all the Ryan user does is review the available messages and approve one of the available ads to be printed on the envelope. There is no indication that the Ryan user is allowed to view the electronic design of the envelope or to modify the design to control the font, color, size, or any other feature related to the design of the advertisement or the other elements of the envelope.

Furthermore, the method of claim 1 requires that an advertisement is incorporated into the electronic product design that was "not provided by the user". This is clearly not taught by Ryan. The Ryan user provides the advertisement for use on the envelope at step 612 of Fig. 6. Referring once again to Ryan col. 12, lines 23-29, an advertisement is not printed on the Ryan user's envelope unless and until that advertisement is specifically selected and approved by the Ryan user.

For the reasons discussed above in connection with independent claim 1, dependent claims 2-7 are likewise patentable. For completeness, the following additional remarks are presented rebutting the additional comments of the Examiner in applying Ryan to dependent claims 2-4.

The Examiner refers to Fig. 5B and Ryan col. 9, lines 10-25 as showing the claimed elements of dependent claim 2. Applicants respectfully disagree. Fig. 5B depicts information stored in user profile 804 in the printer's data processing system

(Fig. 5A). Regarding Ryan's profile 804, (a) it is not a product template, (b) the user cannot incorporate user content into profile 804, and (c) profile 804 does not contain the advertisement that was incorporated into the user's product design.

Dependent claim 3 recites that the user must pay a fee to have the advertisement removed. There is no teaching in Ryan, including the cited sections of col. 9, lines 10-25 and col. 10, lines 5-15, suggesting that the user must pay a fee to have an advertisement removed.

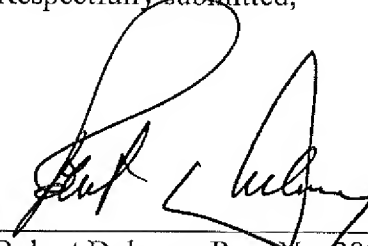
Dependent claim 4 recites that the product design software tools are provided by a business and that the advertisement is a promotional advertisement for the business providing the tools. Ryan repeatedly recites that the advertising is advertising for "third party advertisers". There is no mention of any advertisement being for the company that is providing the advertisement selection system described at col. 12, lines 23-29 in connection with printing the user's envelope.

Regarding independent claim 8, similar arguments as stated above in connection with claim 1 also apply. Claim 8 relates to a method for offering to produce products "from an electronic product design prepared by a user". To the extent there is an electronic design of the envelope, that design is created by the printer, not the user. The user's action of reviewing a group of available advertisements and choosing one to be printed on an envelope otherwise designed entirely by the printer does not make the envelope fall within any reasonable definition of "an electronic product design prepared by a user". Furthermore, claim 8 requires that the advertising that is incorporating into the electronic product design is not provided by the user. The Ryan user, by contrast, clearly provides the advertisement because an advertisement is incorporated only after it has been reviewed, selected, and authorized by the Ryan user.

In view of the above amendments and comments, favorable action and allowance of pending claims 1-8 is respectfully requested.

Please charge Deposit Account 502765 for any fee required by this amendment. If the Examiner believes a phone call would serve to advance the prosecution of this case, he is invited to telephone the undersigned at the number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert Dulaney', written over a horizontal line.

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